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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,781	06/17/2000	GERALD SUGERMAN	GS1010	4332

21874 7590 03/04/2005  
EDWARDS & ANGELL, LLP  
P.O. BOX 55874  
BOSTON, MA 02205

EXAMINER
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JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/581,781

Applicant(s)

SUGERMAN, GERALD

Examiner

Dwayne C. Jones

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11, drawn to a composition containing an unsaturated ester.

Group II, claim(s) 12, drawn to a composition containing a non-hydroxyl bearing unsaturated ester.

Group III, claim(s) 13, drawn to a composition containing a hydroxyl-bearing unsaturated ester.

Group IV, claim(s) 14, drawn to a composition containing an unsaturated ether.

Group V, claim(s) 15, drawn to a composition containing a hydroxyl-bearing unsaturated ether.

Group VI, claim(s) 16, drawn to a composition containing a non-hydroxyl-bearing unsaturated ether.

Group VII, claim(s) 17, drawn to a composition containing an unsaturated ether-ester.

Group VIII, claim(s) 18, drawn to a composition containing a hydroxyl-bearing unsaturated ether-ester.

Group IX, claim(s) 19, drawn to a composition containing a non-hydroxyl-bearing unsaturated ether-ester.

2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: a special technical feature, such as the presence of the functional group of an ester or an ether or even an

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ether-ester or hydroxyl or non-hydroxyl bearing groups on unsaturated compounds varies from each one of the groups.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The various and sundry compounds that are embraced by the functional recitation of compositions containing a non-hydroxyl bearing unsaturated ester, a composition containing a hydroxyl-bearing unsaturated ester, a composition containing an unsaturated ether, a composition containing a hydroxyl-bearing unsaturated ether, a composition containing a non-hydroxyl-bearing unsaturated ether, a composition containing an unsaturated ether-ester, a composition containing a hydroxyl-bearing unsaturated ether-ester, or a composition containing a non-hydroxyl-bearing unsaturated ether-ester and which each further contain a nonvolatile reactive amine compound as well as a saturated/unsaturated hydroxyl-bearing oligomeric glycol or oligool.

Applicant is required, in reply to this action, to elect a *single species* to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

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compositions containing an unsaturated ester (claim 11), compositions containing a non-hydroxyl bearing unsaturated ester (claim 12), a composition containing a hydroxyl-bearing unsaturated ester (claim 13), a composition containing an unsaturated ether (claim 14), a composition containing a hydroxyl-bearing unsaturated ether (claim 15), a composition containing a non-hydroxyl-bearing unsaturated ether (claim 16), a composition containing an unsaturated ether-ester (claim 17), a composition containing a hydroxyl-bearing unsaturated ether-ester (claim 18), or a composition containing a non-hydroxyl-bearing unsaturated ether-ester (claim 19) and which each further contain a nonvolatile reactive amine compound as well as a saturated/unsaturated hydroxyl-bearing oligomeric glycol or oligool (for claims 11-19) but each one of these subgenres needs to specify a single disclosed species that is embraced by these functional recitations.

The following claim(s) are generic: 1-10 and 20-24

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: these subgenres needs to specify a single disclosed species that is embraced by these functional recitations.

A telephone call to the attorney is not required where: 1) the restriction requirement is complex, 2) the application is being prosecuted pro se, or 3) the examiner knows from past experience that a telephone election will not be made, see MPEP Sect. 812.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

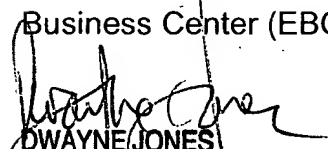
Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (571)-273-8300.

Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).

  
DWAYNE JONES  
PRIMARY EXAMINER  
Tech. Ctr. 1614  
March 2, 2005